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TS.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/335,376	06/17/99	LIM	J 01997/253005

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LM01/0726

EXAMINER

SMITS, T

ART UNIT

PAPER NUMBER

2741

12

DATE MAILED:

07/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/335,376

Applicant(s)
Jae S. Lim

Examiner
Tallvaldis Ivars Smits

Group Art Unit
2741

☒ Responsive to communication(s) filed on February 22 and June 19, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66, 68-72, 74-77, 79-81 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-8 is/are allowed.

☒ Claim(s) 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66, 68-72, 74-77, 79-81, 85-88 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Response to Amendment

1. In response to the Office Action, mailed January 11, 2000, applicants have submitted an inventor's declaration of U.S. citizenship, filed February 22, 2000, and IDS, along with a Response, filed June 19, 2000.
2. Despite examiner's request for the identification in the reissue declaration of *at least one specific error* relied upon to support the reissue application, applicant still makes only a general statement that "prior prosecution failed to claim significant inventive aspects disclosed in the original application" (Amendment, p. 1), without giving at least one specific example of such "significant inventive aspects" that were erroneously not claimed in the original application.
3. Applicant's argument that "there are no 'canceled or amended claims' on which to base application of the recapture rule" (Amendment, p. 2-3), based on examiner's use of an **obsolete** formulation of a recapture rejection making reference only to canceled claims, while correct, is misleading, for this is **not** the only way **surrender** of subject matter may occur.

The Court in *Hester* held that the surrender which forms the basis for impermissible recapture "can occur through arguments alone", even where there was no claim change made (142 F.3d at 1482, 46 USPQ2d at 1649).

Thus, if the limitation now being omitted or broadened in the present reissue was originally **presented/argued/stated** in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously **surrendered** by applicant, and impermissible **recapture** exists. Hence the improper recapture claim rejections are reaffirmed, now based of subject matter deliberately surrendered, below.

Defective Reissue Declaration

4. Claims 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66, 68-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137, and 139-153 are rejected as being based upon a defective reissue declaration under 35 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office Action.

Improper Recapture

5. All of the new claims 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137, and 139-153 are rejected under 35 U.S.C. 251 as being an improper recapture of subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429,

1436, 221 USPQ289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Omitted Claim Limitations

6. The rejected claims are broader in an aspect germane to a prior art rejection by *failing to recite the identical or more narrow versions of at least one of the following limitations*, argued by applicant to make claims allowable over cited the prior art. Said limitations are listed next (in paraphrased form) under the respective Patent and Application number pairs, *at least one of which* limitations was needed for the allowability of every one of the allowed independent claims in said, parent and related continuing, applications, as indicated by their prosecution history:

U.S. Patent 5,394,508 (appl. 07/822,247)

- Quantizing only once the magnitude of the yardstick signal element of each band, it being the signal element having the largest magnitude in the respective band {issued claims 1 and 13 ; original claim numbers 13 and 27, respectively} .

- More preferential bit allocation to a selected signal element if its location is between that of the yardstick signal element (defined, in general, as being of preselected size relative to the other signal elements in its band) and a selected end of the band, rather than being elsewhere {issued claim 8; original claim number 5} .
- Less accurate nonuniform quantization of a non-yardstick signal element, based on the sign of the yardstick element {issued claims 9 and 12; original claim numbers 7 and 22} .
- Specifying a plurality of non-yardstick signal element quantization levels to be within a range of less than the yardstick element magnitude if the yardstick element has positive amplitude; if negative, making the quantization level range less than twice said magnitude {issued claim 11; original claim number 12} .
- Specifying the location of respective yardstick signal elements with respect to at least one dimension within its band as well as the respective sign of the yardstick elements, and accurately quantizing said magnitudes, locations and signs for coding {issued claim 14; original claim number 41}.

U.S. Patent 5,369,724 (appl. 07/879,635)

- Having the magnitude of at least one of the yardstick signal elements (chosen on the basis of its preselected size relative to the other signal elements in its band) be closest to the median of the magnitudes of all the signal elements in its band {issued claim 1; original claim number 6}.

- Having the magnitude of at least one of the yardstick signal elements (chosen on the basis of its preselected size relative to the other signal elements in its band) be closest to the average of the magnitudes of all the signal elements in its band {issued claim 2; original claim number 7}.
- Two-stage quantization of at least one yardstick signal element, and encoding its magnitude and location within its band {issued claim 3; original claim number 8} .
- Quantizing a signal element (of preselected size relative to other signal elements therein) in a band (of preselected size relative to other signal elements therein) as a function of at least two yardstick signal elements {issued claim 4; original claim number 9} .
- Encoding the sign of at least one yardstick signal element for which the location has been encoded {issued claim 5; original claim number 10} .
- Quantizing the magnitude of at least one yardstick signal element for which the location was encoded and of at least one additional yardstick signal element, selecting a non-yardstick signal element in a band for which said location was encoded, allocating bits for the latter as a function of the quantized magnitudes of the at least two yardstick signal elements, the signal decoder translating the code based on said signal element bit allocation {issued claim 6; original claim number 12}.
- Encoding the location of at least one yardstick signal element with respect to its position along at least one dimension in which said signal elements are discrete within its respective band {issued claim 10; original claim number 16} .

- Quantizing the magnitudes of at least one yardstick signal element with encoded location and at least an additional yardstick element, selecting a non-yardstick signal element from the band containing encoded location yardstick and quantizing it as function of the quantized magnitudes of said at least two quantized yardsticks {issued claim 11; original claim number 19}.

U.S. Patent 5,640,486 (appl. 08/345,879)

- Coding of yardstick signal element location relative to the non-yardstick elements and sending that information with the encoded signal for decoding, further using the specific location data for perceptual coding and for decoding {from Indication of Allowable Subject Matter for issued claims 1, 6, 7, and 8 ; original claim numbers 1, 11, 17, and 18, respectively}

Claim Objections

7. Claim 86 is objected to because of the following informalities: It recites a dependence on canceled claim 84. (The previous Office Action inadvertently referred to claim 78, rather than the intended claim 86) Appropriate correction of the dependence is required.

Conclusion

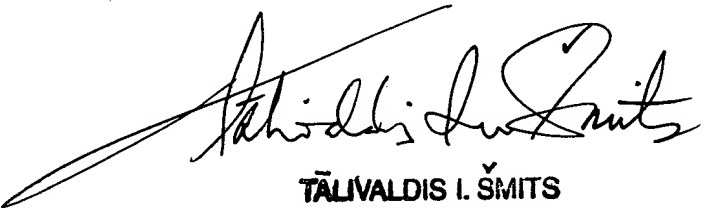
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-

3011. The examiner can normally be reached Mondays-Fridays from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth, can be reached on (703) 308-4825. The facsimile phone number for this Art Unit is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2700 receptionist, whose telephone number is (703) 305-3900

Art Unit 2741
July 25, 2000

A handwritten signature in black ink, appearing to read 'Tāļvaldis I. Šmits', written in a cursive style.

TĀLVALDIS I. ŠMITS
PATENT EXAMINER